

REMARKS

The Office Action has been carefully reviewed. No claim is allowed. Claims 3-10 and 17-27 presently appear in this application and define patentable subject matter warranting their allowance. Reconsideration and allowance are hereby respectfully solicited.

Claims 3-10 and 17-27 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The examiner takes the position that "because the instant specification does not support the language 'consists of' in regards to the structural elements of the DNA required in the claimed methodology, and there is no specific examples which clearly demonstrate that applicant's have provided a specific example of the claimed genus, the instant claims introduces new concepts and violates the written description requirement." This rejection is respectfully traversed.

The examiner is apparently taking the position that by changing the claim language from "comprising" to "consisting of", the claim is no longer supported by the written description. However, this position is untenable. A "comprising" claim includes all of the specifically enumerated species, but is open to include other non-enumerated species. A "consisting of" claim reads only on the specifically enumerated species, but is not

open to the addition of other non-enumerated species. Thus, in the simplest situation, a claim "comprising A+B" certainly discloses A+B but is open to the possibility of other ingredients. Changing that claim to "consisting of A+B" does not add new matter as the claim always included at least A+B. The same is the situation here, even though the body of the claim is somewhat more complicated. If there is written description support for the minimum plus unidentified other things, then there must also be written description support for the minimum. This logic is supported by cases, such as in *In re Wertheim*, 541 F2d 257, 191 USPQ 90 (CCPA 1976), which essentially holds that there is support for the bottom number of a range. A "comprising" claim is akin to an open-ended range. Changing it to "consisting of" limits it to the minimum number in the range. *Wertheim* finds that to be acceptable. See also in *In re Johnson*, 558 F2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977), which states that the specification, having described the whole, necessarily described the part remaining. Merely deleting unenumerated possible additional sequence or elements does not mean that the specification lacks description for the part remaining that was specifically described in the claim. The examiner is challenged to find a case that holds that changing a claim from "comprising" to "consisting of" can possibly result in a lack of written description for the remainder. For all of these reasons,

Appln. No. 10/520,008
Amd. dated May 20, 2008
Reply to Office Action of February 22, 2008

reconsideration and withdrawal of this rejection is respectfully requested.

In view of the above, the claims comply with 35 U.S.C. §112 and define patentable subject matter warranting their allowance. Favorable consideration and early allowance are earnestly urged.

Respectfully submitted,

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